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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,733	12/21/2004	Geoffrey Phillip Dobson	36749-212211	1333
26694	7590	03/29/2007		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER SAUCIER, SANDRA E	
			ART UNIT	PAPER NUMBER
			1651	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
31 DAYS		03/29/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/518,733

Applicant(s)

DOBSON, GEOFFREY PHILLIP

Examiner

Sandra Saucier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 30-49 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

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DETAILED ACTION  
Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 3.1 and 37 CFR 1.475.

In accordance with these rules, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 30–34, drawn to a first composition comprising:

- a) potassium channel opener OR adenosine receptor agonist,
- b) local anaesthetic,
- c) inhibitor of sodium and hydrogen ion transport.

Group II, claims 35–39, drawn to a second composition comprising:

- a) potassium channel opener OR adenosine receptor agonist,
- b) local anaesthetic,
- c) antioxidant.

Group III, claims 40–42, 44, 46, drawn to methods of use of the composition of Group I.

Group IV, claims 43, 45, 49, drawn to methods of use of the composition of Group II.

Group V, claims 47 and 48, drawn to a preserved tissue.

(a) An international or national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical

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relationship among those invention involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) a product and a process specially adapted for the manufacture of said product; or

(2) a product and a process of use of said product; or

(3) a product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) a process and an apparatus or means specifically designed for carrying out said process; or

(5) a product, a process specially adapted for the manufacture of the said product and an apparatus or means specifically designed for carrying out said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

The groups I and III of invention fall within category (2), a product and a method of use of that product.

PCT Rule 13.2 does not provide for multiple compositions or multiple methods of use within a single application. Thus, the first appearing composition is combined with a corresponding first method of use and the additional composition and method claims each constitute a separate group.

In addition to the requirement that a group of inventions must belong to one of the specific categories provided by PCT Rule 13.2, the inventions in the

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category, such as a composition and a method of use of the composition, must have a special technical feature that unites them. See Patent Rules 1.475, where a special technical feature is a contribution OVER THE PRIOR ART. Please see WO 03/063782 [BC] on page 18 where a composition comprising an adenosine receptor agonist, local anesthetic and a conotoxin is disclosed.

Thus, the inventions listed as Groups I and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features as demonstrated above. Since the composition AS CLAIMED is known in the art, see WO 03/063782 [BC] cited above, no special technical feature unites these inventions in a category.

The expression "special technical feature" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art (PCT Rule 13.2). Thus, a feature found in the prior art cannot be considered to be a special technical feature.

#### ELECTION OF SPECIES

In addition if Group I or Group III is elected, a further election of species must be made. This application contains claims directed to the following patentably distinct species: N-amidino-3,5-diamino-6-chloropyrazine-2-carboximide hydrochloride dehydrate or EIPA or HOE-642 or eniporide or Triamterene or EMD 84021 or EMD 94309 or EMD 96785 or EMD 85131 or HOE 694 or B11 B-513 or T-162559, which are the compounds listed in claim 31. Also an election of either a potassium channel opener OR adenosine receptor agonist must also be made.

If Group II or Group IV is elected, a further election of species must be made. This application contains claims directed to the following patentably distinct species: allopurinol or carnosine or CoQ10 or n-Ac cysteine or SOD or GR or GP or catalase or metalloenzymes or glutathione or U-74006F or

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vitamin E or Trolox or Vitamin C or beta carotene or selenium or GLA or alpha lipoic acid or urate or cucumin or bilirubin or proanthocyanidins or epigallocatechin galate or lutein or lycopene or bioflavonoids, or polyphenols, or trolox (R) or dimethylthiourea or tempol (R) or tocopherol or ascorbic acid or carotenoids or CoQ or melatonin, or flavonoids or polyphenols, or aminoindoles or probucol or nitecapone, or 21-aminosteroids or lazaroids or sulphhydryl-containing compounds or ACE inhibitors or beta mercaptopropionylglycine or O-phenanthroline or dithiocarbamate or selegilize or desferal or DMPO or POBN which are the species listed in claim 36. Also an election of either a potassium channel opener OR adenosine receptor agonist must also be made.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and ***a listing of all claims readable thereon***, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit

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1651. The supervisor for 1651 is M. Wityshyn, (571) 272-0926. The normal work schedule for Examiner Saucier is Monday through Friday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (571) 272-0922. The number of the Fax Center for the faxing of official papers is (571) 272-8300.

A handwritten signature in black ink, appearing to be 'S. Saucier', with a stylized, cursive script.

Sandra Saucier  
Primary Examiner  
Art Unit 1651